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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,194	01/16/2004	Cam Beatty	388.0002	4901
25534	7590	03/08/2006	EXAMINER	
CAHN & SAMUELS LLP 2000 P STREET NW SUITE 200 WASHINGTON, DC 20036			DEUBLE, MARK A	
			ART UNIT	PAPER NUMBER
			3651	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/758,194		BEATTY ET AL.	
	Examiner		Art Unit	
	Mark A. Deuble		3651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-7,10-12 and 14-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7,10-12,14-19 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-2, 5-7, 10-12, 14, 18 and 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 states that the main cylindrical guide element is “relatively dimensionally larger than one of said objects...” Claim 21 recites a cylindrical roller “having [a diameter?] substantially greater than the size of the solid objects...” These limitations render the scope of the claim impossible to ascertain because the claims are directed to the conveyor system for moving the objects and not to the combination of the conveyor system and the objects. A size relationship between a part of the conveyor apparatus of the present invention and something that is not part of the apparatus of the present invention may not be claimed because a person operating a similar conveyor apparatus could be guilty of infringing such an apparatus claim depending on a method of using apparatus rather than on the structure of the apparatus as is usually required for infringement of an apparatus claim. Such a relationship may be more appropriately in a claimed directed to a method of using the conveyor apparatus to convey items with a definite size relationship to the cylindrical guide element.

Furthermore, The terms “larger” in claim 1 and “greater” in claim 21 are relative terms which render the claim indefinite. The terms “larger” and “greater” are not defined by the

claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Finally, Applicant should note that "Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). See MPEP § 2115.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 15-17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hurd (U.S. Patent No. 4,457,422).

Hurd shows, in Figs. 7 and 9 a conveyor system with an inlet 104 at a first select position facing a first direction, an outlet 106 at a second select position above the first facing a second direction, and a generally curvilinear and serpentine transportation path disposed between the first and second positions to convey objects from proximate the inlet to proximate the outlet. A first endless conveying element 96/144 having a sterilizable unitary contact surface is in contact with a guide cylinder 122/158 defining a part of the transportation path. The guide cylinder 122/158 drives the first conveying element so that it transport at least one object along a transportation part from proximate the inlet, through an intermediate arcuate path with a vertical component, to proximate the outlet. A second endless conveying element 94/148 having a sterilizable, unitary securing surface positioned adjacent the contact surface of the first endless

conveying element. The securing surface runs along a secured portion of the transportation path extending at least through the intermediate arcuate path so that the at least one object is secured between the first and second conveying elements along the secured portion of the transportation path. The secured portion of the path includes a substantially vertical portion illustrated in Fig. 7 and a completely vertical portion shown in fig. 9. Tensioners 120 and 154 maintain tension on the first conveying element. Thus, Hurd shows all the structure required by claims 15-17 and operates with all the steps required by claim 19.

Allowable Subject Matter

5. Claims 1-2, 5-7, 10-12, 14, 18 and 21-24 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
6. Claim 20 is allowed.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Deuble whose telephone number is (571) 272-6912. The examiner can normally be reached on Monday through Friday except for alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene O. Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3651

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

md

MARK A. DEUBLE
PATENT EXAMINER

